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| 10/615,026 | 07/09/2003 | Francisco Martinez de Velasco Cortina | 3788-008-27 | 8769 |
| 7590 11/22/2004 | | | EXAMINER | |
| Supervisor Patent Prosecution Services PIPER RUDNICK LLP 1200 Nineteenth Street, N.W. Washington, DC 20036-2412 | | | TRIEU, VAN THANH | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 2636 | |

DATE MAILED: 11/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/615,026

Applicant(s)

CORTINA ET AL.

Examiner

Van T Trieu

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 July 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-52 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-52 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>3/10/04</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Oath/Declaration

1. It does not identify the citizenship of the first inventor CORTINA.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-27, 29, 30, 32, 34-36, 38, 40, 41, 49 and 51 are rejected under 35 U.S.C. 102(b) as being anticipated by **Diamond et al** [US 6,698,653].

Regarding claim 1, the claimed radio frequency device comprising a radio frequency antenna embedded on a chip (the RFID tag having microchip 10, 31 or 41, each includes antenna 11, 32 or 42, see Figs. 1, 3 and 4, col. 6, lines 63-65, col. 7, lines 51-58 and col. 9, lines 1-56); and the radio frequency identification mechanism incorporating the radio frequency device (the smart card or tag RFID 32 such as RF baggage tag, RFID card and/or RFID boarding pass, RFID driver's license, bracelet, see Fig. 1, col. 1, lines 6-22 and col. 7, lines 1-7 ; and the radio frequency reader to read information from the radio frequency device (the smart card reader 55, see Fig. 5, col. 7, line 64 and col. 8, lines 4-80).

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Regarding claim 2, the method claimed limitations are met by the apparatus claim 1 above, and including the step of storing first identification information on a chip with a radio frequency antenna (the E-PROM, see col. 2, lines 52-55, col. 3, lines 22-26 and 58-67, col. 6, lines 65-67 and col. 7, lines 1-28); and comparing the first identification information with second identification information to determine if a match exists (comparing the read digital data, see col. 2, lines 59-67, col. 3, lines 28-30 and col. 7, lines 21-49).

Regarding claim 3, all the claimed subject matters are cited in respect to claim 1 above, and including the verifying registration, see col. 1, lines 13-15 and col. 9, lines 55-59).

Regarding claim 4, all the claimed subject matters are cited in respect to claims 2 and 3 above.

Regarding claim 5, all the claimed subject matters are cited in respect to claim 1 above, and including the license plate, see col. 7, lines 4-5.

Regarding claim 6, all the claimed subject matters are cited in respect to claims 2 and 5 above.

Regarding claim 7, all the claimed subject matters are cited in respect to claim 1 above, and including the passenger/driver's facial biometrical, see col. 3, lines 58-61.

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Regarding claim 8, all the claimed subject matters are cited in respect to claims 2 and 7 above.

Regarding claim 9, all the claimed subject matters are cited in respect to claim 1 above, and including identifying an airport passenger.

Regarding claim 10, all the claimed subject matters are cited in respect to claims 2 and 9 above.

Regarding claim 11, all the claimed subject matters are cited in respect to claims 1 and 7 above.

Regarding claim 12, all the claimed subject matters are cited in respect to claims 8 and 10 above.

Regarding claim 13, all the claimed subject matters are cited in respect to claim 9 above, and including the passport and identification card, see col. 3, line 61.

Regarding claim 14, all the claimed subject matters are cited in respect to claims 10 and 13 above.

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Regarding claim 15, all the claimed subject matters are cited in respect to claim 9 above, and including the wireless communication smart card, 9, lines 17-36.

Regarding claim 16, all the claimed subject matters are cited in respect to claims 2 and 10 above.

Regarding claim 17, all the claimed subject matters are cited in respect to claims 7 and 15 above.

Regarding claim 18, all the claimed subject matters are cited in respect to claims 16 and 17 above.

Regarding claim 20, all the claimed subject matters are cited in respect to claim 1 above, and including the RF decal (registration card, col. 1, lines 12-13).

Regarding claim 21, all the claimed subject matters are cited in respect to claims 2 and 20 above.

Regarding claim 22, all the claimed subject matters are cited in respect to claims 7 and 17 above, and including the personal acknowledge (the passenger image and data, see col. 3, lines 58-67 and col. 4, lines 1-8).

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Regarding claim 23, all the claimed subject matters are cited in respect to claims 2, 7 and 17 above.

Regarding claim 24, all the claimed subject matters are cited in respect to claims 1 and 9 above, and including the airport.

Regarding claim 25, all the claimed subject matters are cited in respect to claims 10 and 24 above.

Regarding claim 26, all the claimed subject matters are cited in respect to claims 7 and 22 above.

Regarding claim 27, all the claimed subject matters are cited in respect to claims 7 and 18 above.

Regarding claim 29, all the claimed subject matters are cited in respect to claims 2 and 3 above.

Regarding claim 30, all the claimed subject matters are cited in respect to claim 29 above, and including the sticker (the baggage tag and/or the vehicle's registration card).

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Regarding claim 32, all the claimed subject matters are cited in respect to claims 1 and 29 above.

Regarding claim 34, all the claimed subject matters are cited in respect to claim 29 above, and including the IC or microchip.

Regarding claim 35, all the claimed subject matters are cited in respect to claim 4 above.

Regarding claim 36, all the claimed subject matters are cited in respect to claims 30 and 35 above.

Regarding claim 38, all the claimed subject matters are cited in respect to claims 2 and 35 above.

Regarding claim 40, all the claimed subject matters are cited in respect to claims 8 and 35 above.

Regarding claim 41, all the claimed subject matters are cited in respect to claims 34 and 35 above.

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Regarding claim 49, all the claimed subject matters are cited in respect to claim 1 above, and including the photograph and multi-dimensional bar codes, see col. 3, lines 37-67 and col. 4, lines 1-8.

Regarding claim 51, all the claimed subject matters are cited in respect to claims 2 and 49 above.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

3. Claim 28 is rejected under 35 U.S.C. 103(a) as being unpatentable over **Diamond et al** [US 6,698,653] in view of **Stilp et al** [US 6,334,059].

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Regarding claim 28, **Diamond et al** fails to disclose the method of verifying a user is authorized to download a software application. However, **Diamond et al** teaches that the smart card is used to identified driver, airport passenger, events security at sports events, amusement parks, child, infant, hospital and/or school, see col. 1, lines 7-15 and 60-65. **Stilp et al** suggests that the wireless location system allows an authorized individual or user to wirelessly transmitting command and loading software, see Figs. 1 and 2, col. 4, lines 38-56, col. 45, lines 58-67 and col. 46, lines 1-64. Therefore, it would have been obvious to one skill in the art at the time the invention was made to modify the RFID smart card of **Diamond et al** for identifying and authorized a person or an individual to download software and commands of **Stilp et al** because the RFID smart card ready use to identify persons or individuals with authority and security, which will extending the applications and uses of the RFID smart card without changing the electronics and physical of the RFID smart card.

4. Claims 31 and 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Diamond et al** [US 6,698,653]

Regarding claim 31, **Diamond et al** fails to disclose the identification mechanism is a window sticker. However, **Diamond et al** teaches that the RFID smart card uses as a vehicle registration card for identifying that vehicle and owner, see col. 1, lines 13-14. Since the vehicle's registration paper or tag is placed on the windshield/window of the vehicle. Therefore, It would have been obvious to one skill in the art at the time the invention was made to adapt the RFID smart card to the vehicle's registration paper/tag

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because the RFID smart card is very small can be easily attached to any articles, objects, credit card and/or passport and available in the market.

Regarding claim 37, all the claim subject matters are discussed in respect to claims 31 and 35 above.

5. Claims 33, 39 and 42-48 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Diamond et al** [US 6,698,653] in view of **O'Brien et al** [US 6,203,952].

Regarding claim 33, **Diamond et al** fails to disclose the identification mechanism is a retroreflective article. However, **Diamond et al** teaches that the identification mechanism is a window sticker. However, **Diamond et al** teaches that the RFID smart card uses as a vehicle registration card for identifying that vehicle and owner, see col. 1, lines 13-14. **O'Brien et al** suggests that applications that would benefit from this invention include patterning of inorganic thin films for active and passive electronic circuits, antennas for RFID tags, EMI shielding, patch antenna, and biosensing pattern arrays. Patterned optical surface layers made by this invention could also find use in optical waveguides, electro-optic filters and modulators, holograms, security images, graphics and retroreflective materials. Patterned transparent conductors on both rigid and flexible substrates would find application in liquid crystal display (LCD) computer displays, televisions, touch screens, heated and electrochromic windows, see Figs. 1 and 2, abstract, col. 2, lines 65-67 and col. 3, lines 1-9. Therefore, it would have been

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obvious to one skill in the art at the time the invention was made to adapt the RFID smart card of **Diamond et al** to use on the retroreflective materials such as of **O'Brien et al** since the material of the smart card and antenna are made of conductive layer and non-conductive layers for preventing of physical damage to the smart card as well as to minimize of electromagnetic interference.

Regarding claim 39, all the claimed subject matters are discussed between **Diamond et al** and **O'Brien et al** in respect to claims 33 and 35 above.

Regarding claim 42, all the claimed subject matters are discussed between **Diamond et al** and **O'Brien et al** in respect to claims 1 and 33 above.

Regarding claim 43, all the claimed subject matters are discussed between **Diamond et al** and **O'Brien et al** in respect to claims 1 and 33 above.

Regarding claim 44, all the claimed subject matters are discussed between **Diamond et al** and **O'Brien et al** in respect to claim 42 above.

Regarding claim 45, all the claimed subject matters are discussed between **Diamond et al** and **O'Brien et al** in respect to claims 2 and 33 above.

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Regarding claim 46, all the claimed subject matters are discussed between **Diamond et al** and **O'Brien et al** in respect to claims 7 and 45 above.

Regarding claim 47, all the claimed subject matters are discussed between **Diamond et al** and **O'Brien et al** in respect to claims 2 and 45 above.

Regarding claim 48, all the claimed subject matters are discussed between **Diamond et al** and **O'Brien et al** in respect to claims 2 and 33 above.

6. Claims 50 and 52 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Diamond et al** [US 6,698,653] in view of **Janssen et al** [US 6,427,504].

Regarding claim 50, **Diamond et al** fails to disclose the RFID mechanism is subjected to at least one of: a static bending test, a heat test, a rigidity test, a durability test; and an abrasion test. However, **Diamond et al** teaches that the RFID chip 10 and antenna 12 are constructed as a tag 11 in the form of a boarding pass, baggage tag, bracelet, ID card, driver's license, see Figs. 1 and 5, col. 1, lines 7-22 and col. 7, lines 1-7. **Janssen et al** suggests that an RFID system including a transponder 2 and antenna 3 are carefully selection of construction materials and structural design, so that a delicate balance is achieved in the improved key design. The materials are selected of a flexible or rigid material such as plastic for protecting the RFID tag from any environmental conditions. The testing has demonstrated of the thermal heat, rigidity, flexibility and bending of the RFID tag are critical to the transmission of the RFID tag system, see

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Figs. 1-54, col. 3, lines 1-62, col. 9, lines 12-33, col. 16, lines 47-67, col. 17, lines 33-67, col. 18, lines 1-67, col. 19, lines 1-27 and col. 20, lines 4-17. Therefore, it would have been obvious to one skill in the art at the time the invention was made to implement the RFID system testing of **Janssen et al** to the RFID tag of **Diamond et al** during structure assembly line of the RFID tag for assuring and improving of the quality, reliability and durability of the RFID tag.

Regarding claim 52, all the claimed subject matters are discussed between **Diamond et al** and **Janssen et al** in respect to claims 2 and 50 above.

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Randomsky et al discloses a dual mode RFID transmitter is secured with a wristband worn by the mother and within an ankle and/or wristband worn by the infant. [US 6,211,790]

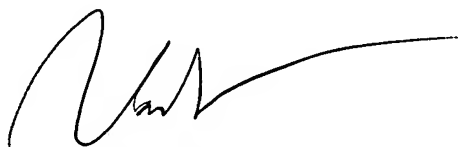
Wang discloses a method and apparatus for approving a transaction request between an electronic transaction system and a portable electronic authorization device PEAD carried by a user. [US 6,175,922]

8. Any inquiry concerning this communication or earlier communications from examiner should be directed to primary examiner **Van Trieu** whose telephone number

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is (571) 272-2972. The examiner can normally be reached on Mon-Fri from 7:00 AM to 3:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. **Jeffery Hofsass** can be reached on (571) 272-2981.

A handwritten signature in black ink, appearing to read 'Van Trieu', with a long horizontal flourish extending to the right.

Van Trieu
Primary Examiner
Date: 11/16/04